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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,510	10/12/2000	Bayard S. Webb	0112300/140	9134

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BELL, BOYD & LLOYD LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER

ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/689,510

Applicant(s)

WEBB ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-13 and 15-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-10,12,13 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

Claims 1, 3, 4, 6-10 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff, U.S. Patent 6,312,334 (Nov. 6, 2001) in view of Schwartz, et al., *The Encyclopedia of TV Game Shows*, 3rd Ed., Checkmark Books (1999) and Koza, U.S. Patent 4,582,324 (Apr. 15, 1986).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Response to Arguments

Applicant's arguments filed April 29, 2004 have been fully considered but they are not persuasive. The applicant contends the claims are non-obvious under USC § 103(a). The arguments generally attack the number of the number of references employed in the rejection and the motivation for combining them. The examiner respectfully disagrees. Responses to the applicant's arguments are provided below.

The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972). There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). There is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention; rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art. *Motorola Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1489 (Fed. Cir.

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1997). In this case, for the reasons detailed below, the prior art taken as a whole collectively suggests to an artisan the features of the claimed invention.

First, regarding the number of references applied in the rejection, a rejection's reliance on a large number of references does not, without more, weigh against the obviousness of the claimed invention. *See In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). In this case, the rejection requires several references because applicant claims more than one distinct feature including: (1) a method and means for displaying game information and (2) a method and means for assigning awards to game selections. The method and means for displaying game information requires that values of the masked awards are disclosed to players without disclosing the association of each of the values with each masked award. The method and means for assigning awards requires that an initial award is selected from a first pool; a second award is selected from a second pool and a third award is selected from a third pool. These are distinct features useable together in a single gaming device. The method of displaying information to players does not require the particulars of assigning values to the information because any method award assignment could be used. For example, the game could employ predefined awards or make a random selection. The feature of assigning awards by making selections from different pools has utility by itself or in other combinations for assigning award values to outcomes in a lottery games having different tiers of awards. Thus, the two features are distinct.

Because the claims are directed to distinct features, the rejection relies on different reference to demonstrate the obviousness of each features. In particular, the rejection employs Encyclopedia to demonstrate that it would be obvious to an artisan to modify Yoseloff to disclose the values of the masked awards to players without disclosing the association of each of the values with each masked award. Koza is employed to demonstrate that it would be obvious to an artisan to modify Yoseloff to select the initial award a first pool; the second award from a second pool and the third award from a third pool.

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The applicant's arguments attack Yoseloff, Encyclopedia and Koza as a group. These arguments fail because Koza is directed to a features distinct from those taught by Encyclopedia. For this reason, the applicant's arguments attempting to show a lack of motivation to combine the references by distinguishing the features of Koza with those of Encyclopedia are unpersuasive.

Second, regarding the features directed to displaying game information, the examiner maintains that it would be obvious to an artisan at the time of the invention to modify Yoseloff to add the feature of disclosing the values of the masked awards to players without disclosing the association of each of the values with each masked award. In this case, Yoseloff discloses gaming systems based on television game shows. It suggests adapting game show themes and features into the devices to enhancing their attraction of players. *See fig. 6, 7; col. 7:18-33*. In one embodiment, Yoseloff describes a LET'S MAKE A DEAL game. *See id.* As in the live television game show, players are offered the opportunity to risk an initial prize in return for the chance to select a hidden prize behind one of three doors, . *See id.*

Encyclopedia describes the details of LET'S MAKE A DEAL ("LMAD"). During the game players were awarded prizes and offered the option of risking their initial prizes for one of several hidden prizes. *See Encyclopedia, p. 125*. LMAD teaches that enticing players to risk a current award for the opportunity to win a award the player knows to be larger at the risk of receiving an award the player knows to be lower is a successful and popular method of adding excitement and tension to games of chance.

Encyclopedia also describes the popular television game show SALE OF THE CENTURY ("SC"). Similar to LMAD, SC included a game in which players were awarded an initial prize and given the option to trade the prize to select one of three hidden awards. *See Encyclopedia, p. 192*. SC differed from LMAD in that players were expressly informed of the award values before electing to gamble their initial award. *See id.* As a result, players are able to judge the risk of taking the chance by calculating the

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difference in values between their current award, the lower award and the higher award. Hence, SC teaches an alternate form of the LMAD game in which players are enticed to risk a current award for the opportunity to win a larger award known to the players at the risk of receiving a lower award known to the players, and thereby allow players to calculate the risk of taking the chance

When the prior art is taken as a whole by an artisan at the time of the invention it collectively suggests modifying the gaming device described by Yoseloff, wherein the theme is based on LET'S MAKE A DEAL and requires players to risk a currently held award for the chance to win an award they know is higher at the risk of obtaining an award they know is lower, to add the feature of disclosing the values of the masked awards to the player without disclosing the association of each of the values with each masked award. The teachings of the prior art as filtered through the knowledge of an artisan suggest the combination of Yoseloff, and Encyclopedia. As taught by LMAD, enticing players to risk a current award for the opportunity to win an award the player knows to be larger at the risk of receiving an award the player knows to be lower is a successful and popular method of adding excitement and tension to games of chance. Furthermore, as taught by SC, this game may be modified by expressly informing players of the values and thereby allow the player to calculate the risk of taking the chance.

Third, regarding the applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning; but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As discussed above, Yoseloff suggests adapting the features of television game shows including LET'S MAKE A DEAL. LMAD teaches the features of the television game show LET'S MAKE A DEAL. SC discloses a similarly

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television game show variation of the game used in LET'S MAKE A DEAL in which players are informed of the values of the possible awards. Thus, as suggested by Yoseloff, when adapting the theme of the television game show LET'S MAKE A DEAL into a gaming device, an artisan would consider the features and elements of known television game shows. The conclusion of obviousness is not based upon improper hindsight because it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure. Thus, the examiner maintains that the construction was proper.

Fourth, regarding the feature of selecting award values from different pools, the examiner maintains that it would be obvious to an artisan at the time of the invention to modify Yoseloff to add the feature of an initial award being selected from a first pool; the second award selected from a second pool and the third award selected from a third pool as alternate means to select game awards

It is commonly known to use different pools of awards associated with different ranges of prizes is a familiar notion. For example, games of skills offered at local fairs allow players to select different ranges of prizes from different pools associated with the player's level of success. If a player failed at the game, then the player might receive a prize from a pool containing a range of consolation prizes (i.e. booby prizes). If a player was partially successful at the game, then the player would receive a prize from a pool containing a range of mid-level prizes. Finally, if the player was fully successful at the game, then the player would receive a prize from a pool containing a range of high level prizes. Hence, it is generally known to select awards from different pools representing different levels of prizes.

Koza discloses a multi-level pool system wherein predetermined game outcomes are selected from different award pools to ensure appropriate distribution of the possible outcomes from each level. *See col. 11:26-31*. A first pool contains low-end awards, a second pool contains a intermediate level awards and a third pool contains high-end awards. *See id.* Notably, *Koza* suggests that other methods of

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generating outcomes are substitutable for the pool-based system; for example, random selection. *See col. 12:28-31.*

In view of *Koza*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device taught by *Yoseloff*, wherein the player is offered the chance to win a prize from one of three levels including an initial award, a high-level award and a low-level award, to add the feature of the initial award being selected from a first pool; the second award selected from a second pool and the third award selected from a third pool as alternate means to select game awards. As taught by *Koza*, selection from multiple pools is a known means of generating random outcomes in gaming devices and is useful in games with multi-level award to ensure appropriate distribution of the possible outcomes from each level.

Thus, the applicant's argument that there is no motivation to combine *Yoseloff* with *Koza* is unpersuasive because the motivation to combine the references is found within *Koza*.

Consequently, for all the reasons given above, the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, primary examiner Jessica Harrison can be reached on 703-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.



MARK SAGER
PRIMARY EXAMINER